

REMARKS

Claims 24, 26, 30, 33, 35, 36, 38, 39, 41, and 42 are pending in the application.

Claim 24 has been amended and claims 25 and 29 have been cancelled by entry of this amendment. Claims 33, 36, 39, and 42 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 24, 25, 29, 33, 35, 36, 38, 39, and 42 stand rejected under 35 U.S.C. § 102(b) over Wozney. Claims 26, 30, and 41 are allowed.

Applicants submit that the proposed amendments of claim 24 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner and request that this amendment under 37 C.F.R. § 1.116 be entered. Furthermore, Applicants respectfully point out that the Final Action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance. Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

I. REJECTION UNDER 35 U.S.C. § 102(b)

The Examiner rejected claims 24, 25, 29, 33, 35, 36, 38, 39, and 42 under 35 U.S.C. § 102(b) over the disclosure of the claimed sequences in Wozney. The Examiner contends that the priority application filed on April 8, 1988 (U.S. Serial No. 07/179,100; now U.S. Patent No. 5,013,649, enclosed in the Reply to Office Action of February 22, 2005) does not disclose a polynucleotide comprising nucleotides 1202-1543 of Figure 2 or a polynucleotide encoding amino acids 283 through 396 of Figure 2. Applicants have amended claim 24 and cancelled claims 25 and 29, thereby removing

polynucleotides comprising nucleotides 1202-1543 of Figure 2 and polynucleotides encoding amino acids 283 through 396 of Figure 2 from the scope of the claims. These claim amendments should overcome the rejection of claims 24, 35, and 38 under 35 U.S.C. § 102(b), and Applicants respectfully request that this rejection be withdrawn.

The Examiner further contends that the hybridization conditions in claim 33 cannot be found in the disclosure of the April 8, 1988 priority document, and thus, claims 33, 36, 39, and 42 are also allegedly anticipated by Wozney. Applicants disagree. The hybridization conditions are specifically disclosed in the priority document, U.S. Patent No. 5,013,649, at column 3, lines 52 to 57:

These DNA sequences include those depicted in Tables I-III in a 5' to 3' direction and those sequences which hybridize under stringent hybridization conditions [see, T. Maniatis et al, *Molecular Cloning (A Laboratory Manual)*, Cold Spring Harbor Laboratory (1982), pages 387 to 389] to the sequences of Tables I-III.

These conditions are further defined at column 13, lines 8 to 10:

... under stringent conditions (hybridization at 65°C in standard hybridization buffer; washing at in 0.2X SSC, 0.1% SDS).

The identical disclosure was provided on page 5, lines 9-15 and page 21, lines 20-22 of the originally filed specification in the priority application, U.S. Serial No. 07/179,100.

As in the currently pending application, the standard hybridization buffer is defined in Maniatis as 6X SSC, 5X Denhardt's solution, 0.01 M EDTA, and 0.5% SDS. The relevant pages of Maniatis were enclosed with the Reply to Office Action of September 9, 2004.

This disclosure of hybridization conditions in the April 8, 1988 priority document is virtually identical to the disclosure in the pending application at page 22, line 23 to

page 4, lines 24 to 28 and page 23, lines 25 to 27. Thus, claims 33 and 42 are entitled to the April 8, 1988 priority date, and Wozney is not prior art to these claims. Applicants respectfully request that this rejection be withdrawn.

II. REJECTIONS UNDER 35 U.S.C. § 112

The Examiner rejected claims 33, 36, 39, and 42 as allegedly lacking written description support under 35 U.S.C. § 112, first paragraph. As shown above, both the priority document's and the pending application's disclosures provide the necessary support for the hybridization claims. Accordingly, the hybridization conditions in claims 33, 36, 39, and 42 are supported by both the currently pending disclosure and the disclosure of the April 8, 1998 priority document. Applicants respectfully request that this rejection under 35 U.S.C. § 112 be withdrawn.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: 8/2/05

By: Elizabeth E. McNamee
Elizabeth E. McNamee
Reg. No. 54,696